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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,426	12/10/2001	Bruno Centola	FR920000069US1	9463

7590

08/14/2002

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EXAMINER

NORRIS, JEREMY C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,426

Applicant(s)

CENTOLA ET AL.

Examiner

Jeremy Norris

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 7-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the citizenship of each inventor.

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Specifically, the above mentioned items are missing for the fourth named inventor, Jacques Feraud.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,537,294, granted to Siwinski (hereafter Siwinski).

Siwinski discloses, referring to figure 2, a printed circuit board (PCB) comprising:
a substrate (20) having a first edge portion and including a ground layer (30) therein;

a substantially U-shaped device (30) secured to said PCB to provide a cover for said first edge portion; and connection means for electrically coupling said substantially U-shaped device to said ground layer within said substrate, said substantially U-shaped device substantially preventing electromagnetic radiation from being emitted from said first edge portion (see col. 3, lines 15-25) [claim 1] wherein said substantially U-shaped device is flexible (see col. 2, lines 55-65) [claim 2], wherein said substantially U-shaped device is of unitary construction (see figure 3) [claim 6], wherein said PCB is adapted for being positioned within a rack or chassis, said PCB including means for electrically coupling said substantially U-shaped device to said rack or chassis (see col. 4, lines 5-25) [claim 13] wherein said means for electrically coupling said substantially U-shaped device to said rack or chassis comprises a projecting ledge (200, see figure 3), said projecting ledge adapted for slidably engaging said rack or chassis [claim 14] wherein said projecting ledge is electrically coupled to said connection means [claim 15].

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,855,873, granted to Bhargava et al. (hereafter Bhargava).

Bhargava discloses, referring to figure 4, a printed circuit board (PCB) comprising: a substrate (55a) having a first edge portion and including a ground layer (59) therein; a substantially U-shaped device (27, 40) secured to said PCB to provide a cover for said first edge portion; and connection means (see col. 9, lines 50-60) for electrically coupling said substantially U-shaped device to said ground layer within said substrate, said substantially U-shaped device substantially preventing electromagnetic radiation from being emitted from said first edge portion (see col. 7, lines 55-65) [claim

1], wherein said substantially U-shaped device comprises first (27) and second (40) substantially L-shaped parts [claim 3], wherein one of said L-shaped parts (40) includes a cavity therein and the other of said L-shaped parts is movably positioned within said cavity [claim 4] wherein one of said L-shaped parts includes a cavity therein and the other of said L-shaped parts includes a compressible projecting part adapted for being compressibly retained within said cavity [claim 5].

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5,500,789, granted to Miller et al. (hereafter Miller).

Miller discloses, referring to figure 6, a printed circuit board (PCB) comprising: a substrate (16) having a first edge portion and including a ground layer (30) therein; a substantially U-shaped device (44) secured to said PCB to provide a cover for said first edge portion; and connection means (44b) for electrically coupling said substantially U-shaped device to said ground layer within said substrate, said substantially U-shaped device substantially preventing electromagnetic radiation from being emitted from said first edge portion (see col. 3, lines 25-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of US 6,318,902, granted to Igl et al. (hereafter Igl).

Miller discloses the claimed invention as described above with respect to claim 1, except Miller does not specifically state that the substantially U-shaped device is secured to said PCB by adhesive. However, it is well known in the art to employ an adhesive to secure a grounding clip to a circuit board as evidenced by Igl (see col. 11, lines 15-20). Therefore, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to use a conductive adhesive to connect the grounding clip to the ground layer in the invention of Miller as is known in the art, and evidenced by Igl. the motivation for doing so would have been to ensure a reliable electrical and mechanical connection.

Allowable Subject Matter

Claims 7-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 7 states the limitation "further including at least one conductive plate movably positioned within said substantially U-shaped device to be electrically coupled to said ground layer within said PCB". This limitation, in conjunction with the other claimed limitations was neither found to be disclosed in, nor suggested by the prior art. Claim 11 states the limitation " wherein said PCB further includes electrically conductive vias or plated through holes (PTHs) as part thereof and coupled to said ground layer, said connection means including a plurality of projecting pins adapted for electrically contacting said conductive vias or said PTHs when said substantially U-shaped device is secured to said PCB". This limitation, in conjunction with the other claimed limitations was neither found to be disclosed in, nor suggested by the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4,771,365	Cichocki et al.,
US 5,563,450	Bader et al.,
US 5,671,123	Omori et al..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7724 for regular communications and 703-305-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN
August 10, 2002



KAMAND CUNEO
PRIMARY EXAMINER